



1731

Docket No. 54821.P1/3520.0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kosaraju Krishna MOHAN, et al.
Serial No.: 09/770,340
Filed: January 26, 2001
For: LOW DENSITY PAPER AND PAPERBOARD ARTICLES
Examiner: Jose Fortuna (703) 305-7498
Group Art Unit: 1731

RECEIVED**FEB 24 2003****TC 1700**RESPONSE TO SECOND RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated January 9, 2003, Applicants submit the following remarks.

Previously, the Examiner issued a requirement that Applicants make an election between the Group I claims (Claims 1 - 19), the Group II claims (Claims 20 - 21) and the Group III claims (Claims 22 - 40). Applicants responded by election of Group III (Claims 22 - 40) with traverse.

With respect to the Group III claims, the Examiner has now issued a second restriction requiring that Applicants make an election between (Claims 22 - 36), and (Claims 37 - 40). Applicants hereby elect Claims 37 - 40, but this election is made with traverse and is solely for the purpose of advancing prosecution of this case. It is believed that the requirement to restrict the invention is improper. The claims are sufficiently related that their respective classes would be thoroughly cross-referenced, and many of the same classes would be searched regardless of which group of claims was elected.

Claims 22 - 36 are directed to a method of making a paperboard material having expanded microspheres. Claims 37 - 40 are directed to a method of making a paperboard cup from a paperboard having expanded microspheres. Hence both sets of claims require that a search for paperboards structures incorporating expanded microspheres be made.

An examination of either of the groups of claims will require a search of substantially the same prior art as an examination of the remaining two claims. Each would require searching all of the art relating to the construction of paperboard materials including expanded or expandable microspheres. Furthermore, separate examination of the various groups of claims may lead to inconsistent examinations and will likely result in duplication of effort. It is therefore a more efficient use of Patent Office manpower and resources to examine all claims which are closely related at one time rather than conducting separate examinations.

Moreover, restriction is not "required" by 35 U.S.C. §121 as suggested by the Examiner. Congress wisely gave the Commissioner the "discretion" to require restriction. According to 35 U.S.C. § 121 "... the Commissioner may require the application to be restricted...." (emphasis added). Likewise, the MPEP § 803 lists two criteria that must be present for restriction to be proper:

- 1) The invention must be independent or distinct; and
- 2) There must be a serious burden on the Examiner if restriction is not required (emphasis added).

Because the Examiner has not shown any serious burden if examination of all the claims is conducted and the claims cover closely related subject matter, Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement, that he examine all claims on their merits, and that he find all claims to define patentable subject matter and issue a Notice of Allowance at his first opportunity.

Respectfully submitted,

LUEDEKA, NEELY & GRAHAM, P.C.

By:



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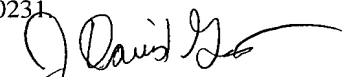
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